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Satoshi Hoshino

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EXAMINER

BORLINGHAUS, JASON M

ART UNIT

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* SATOSHI HOSHINO  
9

10  
11 Appeal 2009-004475  
12 Application 09/899,075  
13 Technology Center 3600  
14

15  
16 Decided: September 23, 2009  
17

18  
19  
20 *Before:* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU  
21 R. MOHANTY, *Administrative Patent Judges.*

22  
23 CRAWFORD, *Administrative Patent Judge.*  
24

25  
26 DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 8, 14, and 15. We have jurisdiction under 35 U.S.C. § 6(b) (2002). The Appellant appeared for oral hearing on September 9, 2009.

Appellant invented an authenticity checker for driver's license (Spec. 1).

Claim 1 under appeal reads as follows:

1. An authenticity checker of driver's license comprising:
  - a driver's license image capturing module for image capturing a watermark of a driver's license from both obverse and reverse side; and
  - an authenticity judging module which judges the driver's license is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the driver's license image capturing module is recognized as a regular watermark, and judges the driver's license is authentic if at least one of watermarks is recognized as a regular watermark.

Claim 14 under appeal reads as follows:

14. A method of authenticating a driver's license, the method comprising:

- gathering first driver's license imaging data based on a watermark on the obverse side of a driver's license, wherein the gathering of first driver's license imaging data further comprises irradiating the driver's license;
- determining if the watermark on the obverse side is regular based on the first driver's license imaging data;

1 if the watermark on the obverse is  
2 determined not regular, gathering second driver's  
3 license imaging data based on a watermark on the  
4 reverse side of the driver's license, and determining  
5 if the watermark on the reverse side is regular  
6 based on the second driver's license imaging data,  
7 and wherein the gathering of first driver's license  
8 imaging data further comprises irradiating the  
9 driver's license;

10 wherein, the driver's license is a forgery if  
11 the watermarks on the obverse and reverse sides  
12 are both deemed not regular, and the driver's  
13 license is authentic if either watermark on the  
14 obverse and reverse side is deemed regular.

15 The prior art relied upon by the Examiner in rejecting the claims on  
16 appeal is:

17 Kofune US 5,483,069 Jan. 9, 1996

18 Disclosed Prior Art at pages 1 to 2 of the Appellant's Specification  
19 (hereinafter "DPA").

20 The Examiner rejected claims 1 to 8, 14, and 15 under 35 U.S.C. §  
21 103(a) as being unpatentable over Kofune in view of DPA.

22  
23 ISSUES

24 Do the recitations in claims 1 to 8 comply with the requirements of 35  
25 U.S.C. § 112, second paragraph?

26 Has the Appellant shown that the Examiner erred in finding that  
27 Kofune discloses a method in which the bill is judged a forgery if both  
28 watermarks from the obverse side and the reversed side are not recognized  
29 as a regular watermark as required by claims 14 and 15?

FINDINGS OF FACT

Appellant's Specification discloses:

it was turned out that there were two kinds of driver's licenses. One is a "face-watermarked type driver's license", whose image data obtained by shooting its obverse show a clear watermark, while the image data of the reverse side do not. The other one is a "back-watermarked type driver's license", whose image data obtained by shooting its backside show a clear watermark, but the image data of the obverse do not. Consequently, the conventional devices that judge the authenticity of a driver's license only by the image data of the obverse may judge an authentic back-watermarked type driver's license to be false by mistake.

(Spec. 1 to 2).

Appellant argues that Kofune does not disclose a watermark on the obverse side and a watermark on the reverse side (App. Br. 13).

Kofune discloses one watermark D (col. 5, ll. 54 to 55; Fig. 8a).

PRINCIPLES OF LAW

*Indefiniteness*

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

*Id.*

1 As the court in *In re Wilson*, 424 F.2d 1382 (CCPA 1970) stated:  
2 “All words in a claim must be considered in judging the patentability of that  
3 claim against the prior art. If no reasonably definite meaning can be  
4 ascribed to certain terms in the claim, the subject matter does not become  
5 obvious- the claim becomes indefinite.” *Id.* at 1385.

6  
7 *Obviousness*

8 In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the  
9 Examiner to establish a factual basis to support the legal conclusion of  
10 obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so  
11 doing, the Examiner must make the factual determinations set forth in  
12 *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Furthermore,  
13 “[‘]there must be some articulated reasoning with some rational  
14 underpinning to support the legal conclusion of obviousness’ .... [H]owever,  
15 the analysis need not seek out precise teachings directed to the specific  
16 subject matter of the challenged claim, for a court can take account of the  
17 inferences and creative steps that a person of ordinary skill in the art would  
18 employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting  
19 *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

20  
21 ANALYSIS

22 *New ground of rejection*

23 Pursuant to 37 C.F.R. § 41.50(b) (2008) we make the following new  
24 ground of rejection. Claims 1 to 8 are rejected under 35 U.S.C. § 112,

1 second paragraph, as being indefinite for failing to particularly point out and  
2 distinctly claim the subject matter which the Appellant regards as the  
3 invention.

4 Line 2 of the claim 1 recites “a driver’s license image capturing  
5 module for image capturing *a* watermark.” (Emphasis added). This  
6 recitation relates to just one watermark. However, lines 6 and 7 recite that  
7 the judging module “judges the driver’s license is authentic if at least one of  
8 *watermarks* is recognized as a regular watermark.” (Emphasis added). This  
9 recitation indicates that there is more than one watermark. Therefore, it is  
10 not understood whether there is one watermark in accordance with the  
11 recitation in line 2 or more than one watermark as recited in lines 6 and 7. It  
12 appears that the Specification discloses one watermark that is either on the  
13 reverse or obverse side indicating that there is only one watermark.

14 However, Appellant’s argument in response to the prior art rejection that  
15 Kofune does not disclose a watermark on the obverse side and a watermark  
16 on the reverse side seems to indicate that there is a watermark on each side  
17 of the driver’s license (App. Br. 13). It is unclear whether claim 1 covers an  
18 authenticity judging module that compares one watermark from both the  
19 obverse and reverse sides or compares a first watermark on the obverse side  
20 and a second watermark on the reverse side.

21 As it is not clear whether claim 1’s authenticity judging module judges  
22 one or two watermarks, claim 1 and claims 3, 5, and 7 dependent thereon are  
23 not in compliance with the requirements of 35 U.S.C. § 112, second  
24 paragraph.

25 Likewise, independent claim 2 recites “*a* watermark” (emphasis  
26 added) in line 2 and recites “*watermarks*” (emphasis added) in line 9 and

1 therefore it is not clear whether claim 2's judging means is judging one or  
2 two watermarks. As such, claim 2 and claims 4, 6, and 8 dependent thereon  
3 are not in compliance with the requirements of 35 U.S.C. § 112, second  
4 paragraph.

5

6 *Obviousness*

7 In comparing the subject matter of claims 1 to 8 with the applied prior  
8 art, it is apparent to us that considerable speculations and assumptions are  
9 necessary in order to determine what in fact is being claimed. Since a  
10 rejection based on prior art cannot be based on speculations and  
11 assumptions, *see In re Steele*, 305 F.2d 859, 862 (CCPA 1962), we are  
12 constrained to reverse, *pro forma*, the Examiner's rejection of claims 1 to 8  
13 under 35 U.S.C. § 103(a). We hasten to add that this is a procedural reversal  
14 rather than one based upon the merits of the rejections.

15 Claims 14 and 15 recite a method of authenticating a driver's license  
16 in which a license having a watermark on the obverse side that is not regular  
17 and a watermark on the reverse side that is not regular is determined to be a  
18 forgery. Kofune does not disclose a watermark on both the obverse and  
19 reverse sides of the bill nor a determination of forgery if neither watermark  
20 is regular. As such, we will not sustain the Examiner's rejection of claims  
21 14 and 15.

22

23 CONCLUSIONS OF LAW/DECISION

24 The rejection of the Examiner of claims 1 to 8, 14, and 15 under 35  
25 U.S.C. § 103(a) is not sustained.



1        This decision contains a new ground of rejection pursuant to 37 C.F.R.  
2    § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection  
3    pursuant to this paragraph shall not be considered final for judicial review."

4        37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO  
5    MONTHS FROM THE DATE OF THE DECISION, must exercise one of  
6    the following two options with respect to the new ground of rejection to  
7    avoid termination of the appeal as to the rejected claims:

8            (1) *Reopen prosecution.* Submit an appropriate  
9            amendment of the claims so rejected or new  
10          evidence relating to the claims so rejected, or both,  
11          and have the matter reconsidered by the examiner,  
12          in which event the proceeding will be remanded to  
13          the examiner. . . .

14          (2) *Request rehearing.* Request that the  
15          proceeding be reheard under § 41.52 by the Board  
16          upon the same record. . . .

17        If Appellant elects prosecution before the Examiner and this does not  
18    result in allowance of the application, abandonment or a second appeal, this  
19    case should be returned to the Board of Patent Appeals and Interferences for  
20    final action on the affirmed rejection, including any timely request for  
21    rehearing thereof.

22        No time period for taking any subsequent action in connection with  
23    this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
24    § 1.136(a)(1)(iv) (2007).

25                            REVERSED; 37 C.F.R. § 41.50(b)  
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27  
28  
29

Appeal 2009-004475  
Application 09/899,075

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